

**REMARKS**

Claims 8 and 10 are amended herein and claims 9 and 15 are canceled. Support is found, for example on page 88 of the specification and in the original claims. No new matter is presented.

**I. Claim Rejections**

Claims 8 and 10-16 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as allegedly being obvious over EP 945 264.

Claims 8 and 10 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by or, in the alternative, as allegedly being obvious over JP 2002-278050.

Claims 8 and 10-16 are rejected under 35 U.S.C. § 102(e) as being anticipated by Iwato et al.

Claims 8 and 10-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP 2002-278050 in view of Shimada, et al.

**II. Applicants' Response**

Claim 8 is amended herein to include the subject matter of claim 15. Further, the onium salt recited in claim 8 is limited to Formula (1-2-A) on p. 88 of the specification, and M<sup>+</sup> is limited to a sulfonium ion.

Applicants claim priority to Japanese App. No. 2003-24499 filed in Japan on January 31, 2003, which precedes the effective date of Iwato et al of September 16, 2003. A sworn English

translation of the priority document is submitted herewith to perfect Applicants' claim to foreign priority. Support for the present claims is found, for example, as follows:

<b>Present Claims</b>	<b>Sworn English Translation of JP 2003-24499</b>
8	Paragraphs [0111] and [0133]-[0135]
10	Paragraph [0119]
11	Paragraph [0019]-[0021]
12	Paragraph [0024]
13	Paragraph [0024]
14	Paragraph [0025]
16	Paragraph [0205]

Accordingly, Iwato et al is removed as prior art.

None of the remaining cited references teach or suggest the specific combination of the photo-thermal converting agent and the onium salt as recited in present claim 8. Thus, the present invention is not anticipated nor rendered obvious by the cited references for at least this reason.

In addition, regarding the §103 rejection based on JP '050 in view of Shimada et al, Applicants submit that there is no motivation to combine the references as suggested by the Examiner. Specifically, Shimada et al relates to a negative planographic printing plate

precursor, whereas JP '050 and the present invention relate to a positive image forming material comprising a positive image forming layer. As previously presented with respect to negative image forming material of Kobayashi et al in the Amendment filed on November 28, 2005, the difference can be considered as a basic difference in image forming mechanisms. The mechanism of the positive image forming material is described in the "Background" section of the present specification.

The negative image forming material of Shimada et al cannot be used as a positive image forming material, which is taught by JP '050. In a negative image forming material, portions exposed to light cure to form image portions, whereas in a positive image forming material, portions exposed to light are dissolved to form non-image portions. Accordingly, the negative image forming material of Shimada et al is totally different from the positive image forming material of JP '050 and of the presently claimed invention. Thus, one of ordinary skill in the art would not have been motivated to combine the references as suggested by the Examiner with a reasonable expectation of success.

In view of the above, Applicants respectfully request withdrawal of the §102 and §103 rejections.

### **III. Conclusion**


In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Amendment under 37 C.F.R. §1.111  
U.S. App. Ser. No. 10/760,497

Q74939

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

  
Jennifer M. Hayes  
Registration No. 40,641

SUGHRUE MION, PLLC  
Telephone: (202) 293-7060  
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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